

REJECTION OF CLAIMS 1, 3, 5, 6, 13 and 15 UNDER 35 U.S.C. §102(b)

Examiner has rejected Claims 1, 3, 5, 6, 13 and 15 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,503,394 issued to Mauck, et al. (hereinafter referred to as "Mauck, et al."). In order for a claim to be anticipated by a prior art reference under 35 U.S.C. §102(b), all elements of the claim must be present in the reference. "A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1015, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Company, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). MPEP 2131. Thus, the Applicant respectfully transverses Examiner on this ground of rejection as to Claims 1, 3, 5, 6, 13 and 15.

Examiner alleges that Mauck, et al., teaches an "outer housing assembly 11, holding rack having an upper stand 33, lower stand 14, connector tube 12, spring biasing mechanism 23, spring bias latching mechanism with latch pin 22." Based on this assertion, the Examiner has rejected Claims 1, 3, 5, 6, 13 and 15 under 35 U.S.C. §102(b). Claims 1, 3, 13 and 15 are all independent claims and Claims 5 and 6 are both dependent claims which depend upon Claim 3.

The Applicant first takes issue with the Examiner's description of the invention described in the Mauck, et al., reference. The holding rack which was identified by the Examiner is not similar to the holding rack of Applicant's invention. The two elements of the holding rack identified by the

Examiner are the upper stand 33 and the lower stand 14. Applicant states that the components labeled as 14 in the Mauck, et al., invention is not a lower stand for a holding rack, but are rather laterally extending finger grip members which are attached on the upper end of the outside wall of the outer housing. The user of the Mauck, et al., invention can use the finger grip members to pull upwardly on the outer housing while the user is depressing the handle 13 to release the arm members of the clamp which holds the golf ball. For the Examiner to argue that the extending finger grip members are in fact a lower stand on a holding rack is simply not accurate, as it is not connected to any sort of holding rack as is the Applicant's invention, and are actually on the outer housing.

The Examiner has argued that 33 of the Mauck, et al., invention is comparable to the upper stand in the holding rack of Applicant's invention. The Mauck, et al., reference identifies 33 as a plurality of club engaging grooves which is present on a handle 13. It appears that the Examiner may have intended to indicate that the combination of the handle 13 and the plurality of club engaging grooves serves as the upper stand on the holding rack.

Each of the independent claims, 1, 3, 13 and 15, identify a holding rack, with an upper stand, a lower stand and a connector tube. The invention disclosed in the Mauck, et al., reference does not have all of these elements. Even if you assume that the combination of the handle 13 and the smaller tubular member 12 could be considered a holding rack, there is nothing in the Mauck, et al., invention which functions as a lower stand. Additionally, Claims 1, 13 and 15 state that the holding rack has an upper stand and a lower stand which are connected by a connector tube. Even if the Examiner still believes that the finger grip members 14 of the Mauck, et al., invention serve as a lower stand of a

holding rack, it is not connected in any way to the upper stand 13, 33. Thus, the Mauck, et al., invention does not anticipate the Applicant's invention as claimed in Claims 1, 13 and 15.

Also, Claims 1 and 15 each have language present in them which specifically identifies that the latching mechanism is "interposed between said outer housing assembly and said holding rack," and Claim 13 states that the latching mechanism is located "within said outer housing." The spring biased latching mechanism with latch pin 22 identified in the Mauck, et al., reference is a "simple leaf spring 27 within member 12" (which has been compared to Applicant's connector tube). Thus, the latching mechanism is not interposed between said outer housing assembly and said holding rack as identified in Claims 1 and 15, but rather the latching mechanism of the Mauck, et al., invention is located specifically in the smaller diameter tubular member 12 or the connector tube of the holding rack. Additionally, Claim 3 identified a latching mechanism located in the upper stand of said holding rack, not in the connector tube 12 as is identified in the Mauck, et al., reference.

For the foregoing reasons, Applicant respectfully requests that the Examiner lift the rejections for Claims 1, 3, 13 and 15 based on 35 U.S.C. §102(b). Accordingly, since Claims 5 and 6 are dependent up on Claim 3, Applicant requests that the Examiner lift the rejections on these claims also.

REJECTION OF CLAIMS 2 and 4 UNDER 35 U.S.C. §103(a)

Examiner has rejected Claims 2 and 4 under 35 U.S.C. §103(a) as being unpatentable over Mauck, et al. Applicant respectfully transverses Examiner on the ground of this rejection as to Claims 2 and 4. Examiner alleges that “although Mauck, et al., is shown used above ground, there is nothing to preclude part of the outer housing being buried underground. The Mauck, et al., accessory would still function. Element 31 is used to secure the device to the ground. To vary the lower part of the housing as mechanically equivalent would have been obvious for one having ordinary skill in the art at the time of the invention.”

Both Claims 2 and 4 state that the “outer housing assembly is mounted underground. The Mauck, et al., invention is not a device which could be used as a golf club holder if its outer housing assembly 11 is placed underground. In order to raise the handle 13 of the Mauck, et al., invention from a depressed position, the user must use “the hands to squeeze the outer tubing. This will cause a friction lock detent 22 to disengage allowing the inner tube member to be forced upwardly by the action of an internal spring 23 (shown in FIG. 6) until a second friction lock detent 24 snaps into place” If the outer housing assembly 11 of the Mauck, et al., invention were to be buried underground as claimed by the Examiner, it would be impossible to release the handle 13 once it had been depressed, as the friction lock detent 22 would be buried also. The Mauck, et al., patent does not provide any teaching for a mechanism which would allow the handle 13 to be forced upwardly, independent of the friction lock detent 22 which works with the outer housing assembly 11 of the invention.

Another important distinction of the Mauck, et al., invention is that the ground anchoring member 30, which is imperative to allow the Mauck, et al., invention to support a golf club, has no means or mechanism by which it could be raised once it is placed underground. Thus, if it was included on an underground version of the Mauck, et al., invention, it would be a stationary pole standing out from the ground even when the outer housing assembly 11 were to be placed underground. Without the ground anchoring member 30, the Mauck, et al., invention would most likely not be capable of supporting a golf club, as the handle 13, which has a plurality of club engaging grooves 33, would not provide sufficient support. There is no discussion of the ability of the Mauck, et al., invention to function as a golf club holder without the presence of the ground anchoring member 30. In fact, the reference specifically states that “[g]rooves in the handle and a ground penetrating rod cooperate to have the unit function as a holder for up to four clubs.” Additionally, the Mauck, et al., reference states that an object of the invention is to “provide a new and improved golfing accessory which provides a **portable** on-course holder for up to four golf club” (emphasis added).

The language in the Mauck, et al., reference makes clear that there was never any suggestion or motivation on the inventor’s part for the invention to be a stationary product which could be buried underground, but rather a portable golfing accessory. Thus, the Applicant respectfully argues that the Mauck, et al., reference provides no suggestion that the invention could be buried underground and serve as a club holder.

Applicant urges that the aforementioned reference and allegations do not establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. Thus, Examiner must follow the criteria necessary to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine referenced teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claimed limitations. MPEP 2143.

Applicant urges that the above criteria have not been met in regard to the instant invention.

Examiner has put forward no evidence beyond conclusory statements of conventionality that suggest modifying the reference or finding success in the modification.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071; 5 USPQ 2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347; 21 USPQ 2d 1941 (Fed. Cir. 1992); MPEP 2143.01.

Furthermore, the ability to modify the reference does not necessarily establish a *prima facie* case of obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680; 16 USPQ 2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

The Examiner has provided no evidence as to a suggestion within the prior art of the desirability of the modifications of Mauck, et al., proposed by Examiner. The Examiner cannot cite to such a suggestion, because such a combination is in fact novel and unobvious. As held by the court in In re Mills, there must be some suggestion in the prior art of the desirability to modify the reference.

The Examiner has taken the admitted lack of disclosure in the Mauck, et al., reference and stated that to bury the lower part of the housing would have been obvious to one skilled in the art at the time of the invention. Such a conclusion, however, can only be made in reliance upon the direct teachings of the disclosure in the present application as the combination, suggestion or suggestion to modify relied upon by the Examiner is not found in the reference cited by the Examiner. The Examiner has thus used impermissible hindsight reconstruction, taking the direct teachings of the present application and filled in the gaps, which are not evident nor even remotely suggested in the cited reference. Impermissible hindsight must be avoided and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art (See MPEP §2142).

The Examiner has failed to cite any explicit disclosure of the possibility that the Mauck, et al., invention could be buried underground in the cited reference but has rather relied on the teachings of the present application as the motivation to modify. Such use of Applicant's own disclosure is expressly prohibited and inappropriate in a 35 U.S.C. §103 rejection. "The teaching or suggestion to make the claim combination and the reasonable expectation of success must be both found in the prior art, not in Applicant's disclosure." In re Vaack, 947 F2d 488 (Fed. Cir. 1991). The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without

the slightest recourse to the teachings of the patent application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation, which is not the standard with which obviousness is determined. Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F2d 1200 (Fed. Cir. 1991).

Therefore, Applicant urges that the criteria for establishing a *prima facie* case of obviousness have not been met by the rejection of Claims 2 and 4. The claimed invention, as claimed in Claims 2 and 4, includes mounting of the outer housing assembly underground. Mauck, et al., does not teach nor suggest securing the device underground for use.

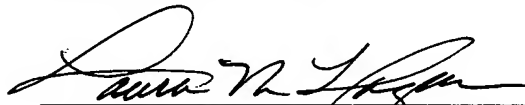
Therefore, not all the elements of the claimed invention are taught or suggested by Mauck, et al. Thus, Applicant respectfully requests that Examiner withdraw this basis of rejection of Claims 2 and 4.

Application No.: 10/715,156
Inventor: Wright
Title: Golf Club Holding Rack
Response to O.A. dated January 6, 2005

CONCLUSION

Applicant respectfully requests Examiner to reconsider the application and to pass the present application to allowance. If the Examiner believes that unresolved issues remain in this case, Applicant respectfully requests Examiner contact Applicant's attorney of record listed below.

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Encl: Form PTO/SB21; Return postcard for evidencing receipt of above items

cc: Brent Wright